

REMARKS

At the time of the Office Action dated December 14, 2006, claims 1-13 were pending and rejected in this application.

CLAIMS 1-5 ARE REJECTED UNDER 35 U.S.C. § 101

On page 3 of the Office Action, the Examiner asserted that the claimed invention, as recited in claims 1-5, is directed to non-statutory subject matter. This rejection is respectfully traversed.

On page 2 of the Office Action, the Examiner asserted the following:

Claims 1-5 are directed to computer programs claimed as computer listings per se, i.e., the descriptions or expressions of software programs because the "System" limitation recited, in claims 1-5, does not necessarily mean a hardware system and could be a software-only-system, exclusive of those that are "computer-readable." Accordingly, they do not define any structural and functional interrelationship between the software program and other claimed elements of a computer which permit the software program's functionality to be realized.

Applicants are unaware of any "software-only-system" that is capable of being "configured to process said business rules." Software alone is incapable of doing anything because it is disconnected from hardware. Software alone is covered under M.P.E.P. § 2106.01 with regard to "functional descriptive material." Claims 1-5, however, are not directed to "functional descriptive material." Instead, claims 1-5 are directed to a system. Therefore, claims 1-5 are not directed to software alone.

Applicants also note that the Examiner's assertion that a system limitation does not necessarily mean a hardware system is a conclusory statement that lacks both factual and legal support. The Examiner has neither cited any case law that supports the Examiner's position nor

set forth a cogent argument as to why a system does not necessarily refer to a hardware system. In this regard, Applicants note that claim 1 recites "at least one widget programmed to be ...". Software alone is incapable of being "programmed." Instead, software alone is the program. Thus, the claimed at least one widget cannot be software alone, as alleged by the Examiner.

Therefore, for the reasons stated above, the Examiner has failed to establish a proper prima facie case under 35 U.S.C. § 101. Thus, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1-5 under 35 U.S.C. § 101.

CLAIMS 1-13 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON UNDERWOOD, U.S. PATENT NO. 6,601,233

On pages 3-5 of the Office Action, the Examiner asserted that Underwood discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.² This burden has not been met.

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

² Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., *supra*.

Claim 1

Claim 1, in part, recites:

a policy comprising a plurality of business rules for configuring said at least one widget in the user interface based upon a context provided by said at least one widget.

On pages 3 and 4 of the Office Action, with regard to this particular limitation, the Examiner asserted the following:

a policy comprising a plurality of business rules ("Application Logic is the expression of business rules and procedures [and the] Application Logic includes the control structure that specifies the flow for processing for business events and user requests." col. 125, lines 39-43; *see also* ". ..business rules..." col. 316, lines 24-26) for configuring said at least one widget in the user interface based upon a context provided by said at least one widget ("AddToUIContext [:] Add a User Interface component to the UI context of the activity." col. 32, lines 27-28);

Upon reviewing the passages cited by the Examiner, Applicants note that the Examiner's citations to column 125 and column 316 are completely silent with regard to "configuring said at least one widget in the user interface," as claimed. Moreover, the Examiner's citation to column 32 is completely silent as to the application logic/business rules described in column 125 and the control logic described in column 316. Therefore, it appears that the Examiner is manufacturing a single specific teaching in Underwood so as to identically disclose the claimed limitation by combining multiple completely unrelated teachings from Underwood. However, Applicants respectfully submit that one having ordinary skill in the art would not have recognized Underwood as teaching the claimed "policy comprising a plurality of business rules for configuring said at least one widget in the user interface based upon a context provided by said at least one widget" since the relied upon teachings within Underwood are unrelated. Thus, Underwood fails to identically disclose the claimed invention, as recited in claim 1, within the meaning of 35 U.S.C. § 102.

Claims 6 and 10

Claims 6 and 10 each recite, in part, the following limitations:

evaluating business rules for configuring the user interface widget according to context information for the user interface widget.

Thus, similar to claim 1, claims 6 and 10 are also directed to business rules that are used to configured a user interface widget. On page 5 of the Office Action, the Examiner also cited column 316, lines 27-28 and column 32, lines 27-28 for support in teaching the above limitation. However, as already noted with regard to claim 1, the teachings found in these respective passages do not refer to one another, and thus are completely unrelated. Thus, one having ordinary skill in the art would not have recognized Underwood as teaching the claimed "evaluating business rules for configuring the user interface widget according to context information for the user interface widget." Therefore, Underwood fails to identically disclose the claimed invention, as recited in claims 6 and 10, within the meaning of 35 U.S.C. § 102.

Thus, for the reasons stated above, the Examiner has failed to establish a proper prima facie case of anticipation for rejecting claims 1-13 under 35 U.S.C. § 102 based upon Underwood. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 1-13 under 35 U.S.C. § 102 for anticipation based upon Underwood.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the

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prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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